

REMARKS/ARGUMENTS

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

Specification

The Applicant has updated Pages 1 and 2 of the specification by replacing the paragraphs entitled "Cross-Reference to Related Applications" with new updated paragraphs, merely to replace US patent application numbers by their corresponding US granted patent numbers, where applicable. The applicant submits that these amendments introduce no new matter.

The Applicant has amended claims. The Applicant respectfully submits that the amendments to the claim set are fully supported by the originally filed specification.

Claims Amendments

Claim 1 has been amended to specify that the form comprises at least one page, the form contains information relating to user registration, each page of the form including a plurality of coded data tags, each coded data tag being indicative of an identity of the form and of a position of the tag on the form. Support for coded data tags can be found at pages 16 and 17 of the specification relating to "Tag Data Content".

Claim 1 has also been amended to specify identifying, in the processing system and from the identity of the form and the time varying position information indicated by the indicating data, at least one parameter relating to user registration.

Similar amendments have also been performed to independent claims 13, 24 and 30. A number of the dependent claims have been amended to specify coded data tags.

Claim 10 has been amended to specify that at least some of the coded data tags are substantially coincident with the information relating to user registration. Support for this amendment can be found from Figure 1 which shows that at least some of the tags 4 are coincident with the information of the request form 1. Claim 10 has also been amended to be dependent from claim 11, and claim 11 has been amended to be dependent upon claim 9. Similar amendments have also been performed in relation to claims 22, 29 and 34.

Claim Rejections – 35 USC § 103

The Examiner has rejected claims 1-10, 12-22, 24-28, 30-33 as being unpatentable over Wolff et al (US Patent Number 6,081,261) in view of Sekunder (US Patent Number 5,477,012).

Applicant respectfully disagrees with the Examiner's conclusion.

M.P.E.P. §2143 sets forth the requirements of a prima facie case of obviousness:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Wolff discloses a single digital coded marking, in a preferred form a barcode, on each page, indicated by reference number 13. The digital coded marking identifies the page. The user initially senses the digital coded marking, prior to moving the sensing device over the surface of the paper. Movement of the sensing device is determined using gyroscopes contained within the sensing device.

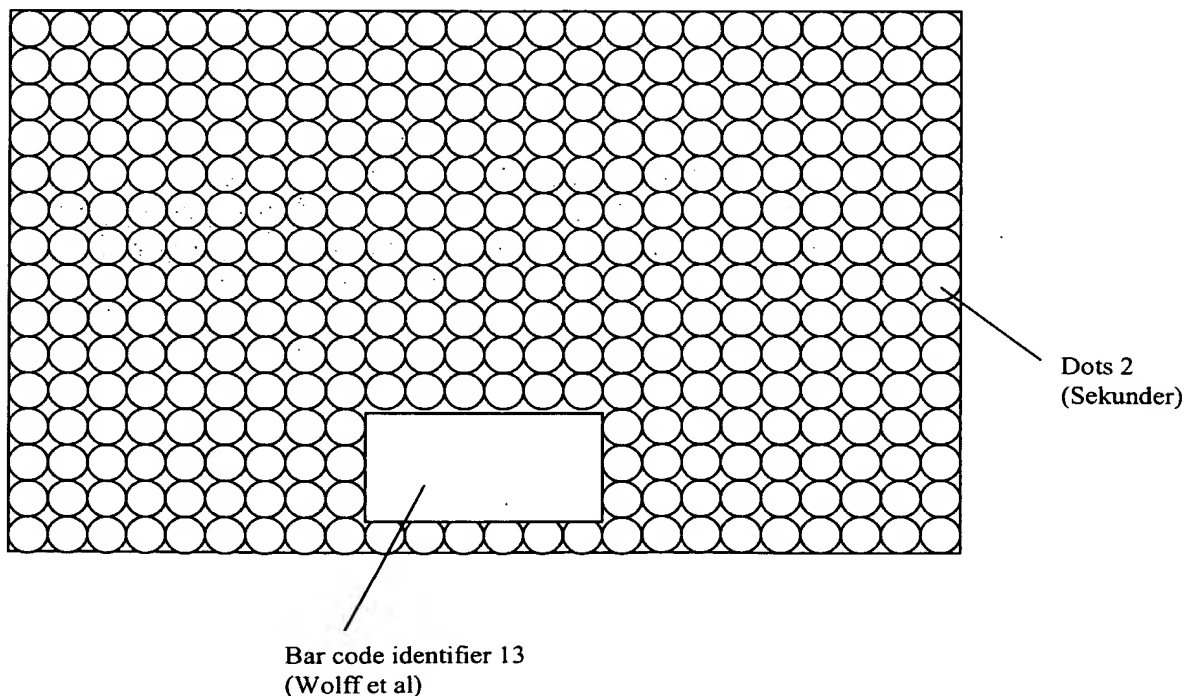
Wolff does not disclose each page of the form including a plurality of coded data tags, and each coded data tag being indicative of a position of the tag on the form.

Sekunder discloses a plurality of dots on a page designating X-Y coordinates. During the process of writing on the page using a sensing device, the writing surface is scanned of coordinates, and is output onto a screen.

Sekunder does not disclose each coded data tag being indicative of an identity of the form.

The Examiner has argued that the combination of Wolff et al in view of Sekunder would result in the claimed method and system being obvious. The Applicant respectfully disagrees.

Assuming that for the sake of argument that it is proper to combine Wolff with Sekunder, the teachings of these documents would lead to one of ordinary skill in the art providing a form having two types of coded data on each page: the single digital coded marking 13 of Wolff, and the plurality of dots 2 of Sekunder, as illustrated below:



There is no teaching, suggestion or motivation in either Wolff or Sekunder regarding the two forms of coded data being integrated into a single coded data tag. Integrating the two forms of coded data into a single coded data tag, such that the tag is indicative of both the identity of the form and a position of the tag on the form would clearly not be obvious as there is no teaching, suggestion or motivation for such a substantial reconstruction and redesign to the coded data.

Furthermore, M.P.E.P. §2143.01(III) states:

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

The Applicant respectfully submits that Wolff and Sekunder fails to disclose any desirability of each tag being indicative of an identity of the form and a position of the tag on the form.

Accordingly, Wolff in view of Sekunder fails to teach, suggest, or motivate each page of the form including a plurality of coded data tags, each coded data tag being indicative of an identity of the form and a position of the tag on the form. Applicant respectfully submits, therefore, that the rejection of the pending claims under 35 USC § 103 as unpatentable over Wolff in view of Sekunder should be withdrawn.

The Applicant also submits that a number of the dependent claims also include patentable subject matter over the cited references. In particular, claims 10, 13, 24 and 30 specify that at least some of the coded data tags are substantially coincident with the information relating to user registration, or the registration information. Wolff shows that the bar code identifier 13 is positioned separately to information on the page. Sekunder fails to disclose any information relating to the form being displayed on the page. Neither of the citations, alone, or in combination, disclose the feature of at least some of the coded data tags being substantially coincident with the information relating to user registration or the registration information. The Applicant respectfully submits that claims 10, 13, 24 and 30 are patentable over the cited documents.

In regard to the Examiner's comments in the Advisory Action that the combination or modification of Wolff with Sekunder is proper, the Applicant still respectfully disagrees with the Examiner's comments.

Although the Examiner has highlighted a different embodiment of Wolff using multiple transmitters in a triangulation process to determine the position of the PI 91, this does not disprove that the proposed modification suggested by the Examiner changes the principle operation of Wolff.

Simply put, the multiple transmitters of the triangulation embodiment of Wolff would also have no purpose in the modified system suggested by the Examiner, as the coded data modified with Sekunder would indicate the position.

Any modification of any of the embodiments disclosed by Wolff, that being the use of gyroscopes to determine position, the use of an infrared detector and a multiplicity of IR radiating scanning sources to determine position using triangulation, or the use of an IR transmitter to determine position using triangulation, would result in either the gyroscope, the infrared detector, or the IR transmitter having absolutely no purpose in the modified method and system, because the position is determined by the dots of Sekunder.

M.P.E.P. §2143.01(IV) which states that:

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)”

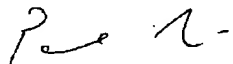
The Applicant respectfully submits that the Examiner's combination or modification of Wolff with Sekunder is not proper, as the principle purpose of determining the position in Wolff using gyroscopes or triangulation equipment is entirely useless. Therefore, the Applicant submits that the teachings of Wolff and Sekunder are not sufficient to render the claims *prima facie* obvious.

Reconsideration and withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

Applicants:



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